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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,572	09/19/2005	Hiroyuki Kurimura	278481US0PCT	9551
22850	7590	12/17/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			MULLIS, JEFFREY C	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			12/17/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/549,572	Applicant(s) KURIMURA ET AL.	
	Examiner Jeffrey C. Mullis	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11-20-08</u> | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moczygemba et al. (US 5,705,569).

Patentees disclose a polymodal styrenic block copolymer composition in which 3 consecutive charges of initiator and styrene are used followed by a mixed charge of styrene/diene in specific amounts. Note Table 5 in this regard. While applicants various molecular weight ratios are not disclosed, those skilled in the art would deduce such ratios approximately based on the disclosure of Table 5 in that it is assumed in the art that one mole of alkyl lithium initiator initiates one mole of polymer chains. Thus the top molecular weight resulting from a particular charge of alkyllithium and monomer would be proportional to the amount of monomer and inversely proportional to the total amount of monomer added with the charge of alkyl lithium (or immediately after) and any charges of monomer added with subsequent charges of alkyl lithium (adjusted for the fact that some of the monomer will polymerize with the subsequent charge of alkyl lithium as well as with the polymeric species resulting from the first charge). A minimum ratio of M1/M3 for the ranges in Table 5 by for instance selecting an initiator level of

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0.001, 0.002 and 0.002 for the first, second and third charges respectively and an amount of monomer for the first second and third charges of 48,12 and 6 (such as falls within the disclosure of Table 5) calculates as 16 which assumes that none of the monomer added subsequent or with the second charge of alkyl lithium adds to the species resulting from the first alkyl lithium addition. Given that there would be 4 times as much active lithium present in the form of second and third charges of alkyl lithium, this assumption would more than reasonably appear to indicate M1/M3 less than 25 as required by the claims. Linear block copolymers would result from coupling with difunctional coupling agents such as are disclosed by the patent and as would be understood by those skilled in the art. With re to applicants polydispersities, polydispersities resulting from a single charge of alkyl lithium and a single charge of monomer are understood by those skilled in the art to be generally fairly narrow and applicants lower value of polydispersity of 3.25 is roughly double of what those skilled in the art would expect from a single charge of styrene and butyl lithium. However given the multiple additions of alkyl lithium and monomer, those skilled in the art would assume substantial broadening of molecular weight distribution for the above proposed charge sequence such than molecular weight distribution would lie within the metes and bounds of the claims. While the examples of the patent do not reasonably appear to inherently produce styrene blocks with applicants M1/M3, for the reasons set out above those skilled in the art would assume that applicants characteristics would be inherently produced by choice of monomer and imitator amounts falling within the ranges of Table 5. Hence to arrive at applicants composition based on the patent disclosure would have

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been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/549,574. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims overlap.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The Declaration under 37 CFR 1.132 filed 11-17-08 is insufficient to overcome the rejection of claims 1-28 based upon Moczygemba ('569) as set forth in the last

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Office action because: Firstly, applicants have used a much higher ratio of butyl lithium to coupling agent in the inventive example (hereinafter "experiment 2") than in the example supposedly according to Moczygamba'569 (hereinafter "experiment 1") and as the number of moles of chains generated is assumed in the art to be equal to the number of moles of initiator in alkyl lithium initiated polymerization of styrene/dienes, the amount of uncoupled polymer and/or branching would be expected to be substantially different in example 1 than in example 2. It is noted that the uncoupled polymer would be expected to not possess all terminal styrenic blocks and that SBC's with terminal styrenic blocks are well known in the art to have much different properties than those without. In any case the presence of different levels of coupling and or branching in experiment 1 and 2 products rely on limitations not present in the claims. Secondly, no data regarding the coupling agent is disclosed by applicants declaration and it is therefore unclear if the same ratio of coupling agent to active chains is used in experiment 1 as in the reference. Thirdly, the reference requires THF or other polar modifier such as is not present in either experiment 1 or 2. Fourthly, (a minor objection), given that the density of applicants catalyst solution is not reported it is not clear the amount of butyl lithium is the same in the reference as in example 1. Fifthly, item 11 recites that the energy absorbed is 0.015 in experiment 2 while the Table on page 7 reports a value 10 times higher. Sixthly, impact strength would be expected to be higher for applicants compositions since applicants copolymers have substantially more butadiene and therefore allegations regarding impact strength are not unexpected

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Applicant's arguments filed 11-17-08 have been fully considered but they are not persuasive.

The defects in applicants declaration have been set out above. With regard to applicants various arguments dealing with the prima facie case of obviousness, it is true that no example having all of applicants limitations in combination are not present in the reference. and specifically embodiment 3. However, as set out in the above rejection all of applicants limitations are taught by the reference or are features which those skilled in the art would assume would arise naturally from following the teachings of the reference. It is noted that applicants various limitations appear to be inherent in example 1 except for differences in claimed vinyl aromatic content (which lie within the broad teachings of the reference) and a different polydispersity in experiment 1 than required by the claims. However the polydispersity of experiment 1 is only slightly lower than required by the claims despite the fact that much greater polydispersities would be expected by varying the ratios of styrene monomer in the various charges as well as amounts of initiator. Applicants allege different properties between their materials and those of the reference but unless applicants can provide data properly comparative to the closest prior art (in the instant case that relied upon) of properties which are unexpectedly improved, such allegations are not probative of patentability.

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Any inquiry concerning this communication should be directed to Jeffrey C.

Mullis, 9-5pm, M-F at telephone number 571 272 1075.

Jeffrey C. Mullis
Primary Examiner
Art Unit 1796

JCM

12-11-08

/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796